

Applicant : McKerracher et al.
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Attorney's Docket No.: 12552-002001 / 256-128US

REMARKS

Status of the claims

Claims 32 and 33 are pending in this application. Claims 25-29 have been withdrawn because they were asserted by the Examiner to be drawn to a separate invention. Claims 22-24, 30 and 31 have been cancelled without prejudice by the above amendments and new claims 32 and 33 have been added by the above amendments. New claim 32 is based upon cancelled claims 24 and 30 and is supported by the specification, e.g., at page 14, lines 3 to 9, and page 28 lines 16 to 26. New claim 33 is supported by the specification, e.g., at page 20, line 16, and page 23, line 10. No new matter has been added.

Priority

In regard to the comments on page 2, paragraph 3, of the Office Action, Applicants will shortly submit a certified copy of the priority document (Canadian Patent Application No. 2,214,841) referred to by the Examiner.

35 U.S.C. §112, first paragraph, rejections

(a) Claims 22-24 and 30-31 stand rejected under 35 U.S.C. §112, first paragraph, on the grounds that they contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

From the comments on page 4, line 3 to page 5, line 8, of the Office Action, Applicants understand the Examiner's position to be that, while the specification provides adequate written description for the use of ADP-ribosyl transferase C3, it does not do so for all the embodiments covered by claims 22-24, and 30-31. While Applicants do not agree with the Examiner's position, Applicants submit that this rejection is rendered moot by the above amendments to the claims which limit them to the use of ADP-ribosyl transferase C3.

(b) Claims 22-24 and 30-31 stand rejected under 35 U.S.C. §112, first paragraph, on the grounds that the specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and use the invention commensurate in scope with the claims.

From the comments on page 5, line 18 to page 9, line 5, of the Office Action, Applicants understand the Examiner's position to be that the specification is enabling for a method of overcoming axonal growth inhibition by delivery of ADP-ribosyl C3 transferase to the CNS or PNS. In light of this consideration, Applicants respectfully submit that the above amendments to the claims limiting them to this embodiment render this rejection moot.

In view of the above arguments, Applicants request that the rejections under 35 U.S.C. §112, first paragraph, be withdrawn.

35 U.S.C. §112, second paragraph, rejection

Claims 22-24 and 30-31 stand rejected under 35 U.S.C. §112, second paragraph, on the grounds that they are indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention.

From the comments on page 9, line 13 to page 10, line 8, of the Office Action, Applicants understand the Examiner's position to be that the terms "Rho antagonists", "Rho-family antagonists", "A-37", "Y-27632", "promoting regeneration", and "damaged neurons" are indefinite. In view of the above amendments to the claims that removed these terms, Applicants submit that this rejection is moot.

In light of the above considerations, Applicants respectfully request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

35 U.S.C. §102(b) rejections

(a) Claims 22, 24 and 30-31 stand rejected under 35 U.S.C. §102(b) on the grounds that they are anticipated by Somlyo.

From the comments on page 10, line 17 to page 11, line 6, Applicants understand the Examiner's position to be that, because Somlyo discloses administration of Y-27632 to animals, the reference anticipates the recited claims. While Applicants do not agree with the Examiner's position, in light of the above amendments to the claims limiting them to the use of ADP-ribosyl transferase C3, Applicants submit that the rejection is rendered moot.

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Applicants submit, in addition, that in view of the October 31, 1997, priority date of the instant application, Somlyo is not a prior art reference. As stated above, Applicants will shortly submit a certified copy of the relevant priority document.

(b) Claims 22, 24 and 30-31 stand rejected under 35 U.S.C. §102(b) on the grounds that they are anticipated by Zipkin et al.

From the comments on page 11, lines 9-14, of the Office Action, Applicants understand the Examiner's position to be that, because Zipkin et al. discloses mig2 mutant-mediated neuronal outgrowth, the reference anticipates the recited claims. While Applicants do not agree with the Examiner's position, in light of the above amendments to the claims limiting them to the use of ADP-ribosyl transferase C3, Applicants submit that the rejection is rendered moot.

Applicants submit, in addition, that in view of the October 31, 1997, priority date of the instant application, Zipkin et al. is not a prior art reference. As stated above, Applicants will shortly submit a certified copy of the relevant priority document.

(c) Claims 22-24 and 30-31 stand rejected under 35 U.S.C. §102(b) on the grounds that they are anticipated by Bartsch et al.

From the comments on page 11, line 17 to page 12, line 2, of the Office Action, Applicants understand the Examiner's position to be that, because Bartsch et al. discloses increased axonal regrowth after application of IN-1 antibody specific for the growth inhibitors NI-35 and NI-250, the reference anticipates the recited claims. While Applicants do not agree with the Examiner's position, in light of the above amendments to the claims limiting them to the use of ADP-ribosyl transferase C3, Applicants submit that the rejection is rendered moot.

(d) Claims 22-24 and 30-31 stand rejected under 35 U.S.C. §102(b) on the grounds that they are anticipated by Zalish et al.

From the comments on page 12, lines 5-10, of the Office Action, Applicants understand the Examiner's position to be that, because Zalish et al. discloses "attenuation of axonal loss following optic nerve crush treatment with gangliosides which inherently prevents (sic) GTP change," the reference anticipates the recited claims. While Applicants do not agree with the

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Examiner's position, in light of the above amendments to the claims limiting them to the use of ADP-ribosyl transferase C3, Applicants submit that the rejection is rendered moot.

(e) Claims 22, 24 and 30-31 stand rejected under 35 U.S.C. §102(b) on the grounds that they are anticipated by Dillon et al.

From the comments on page 12, lines 13-18, of the Office Action, Applicants understand the Examiner's position to be that, because Dillon et al. discloses "a C3 transferase assay in brain homogenates which comprise administration of C3 transferase to neuronal cells of the CNS of a subject", the reference anticipates the recited claims. While Applicants do not agree with the Examiner's position, in light of the above amendments to the claims limiting them to delivery of ADP-ribosyl transferase directly to a CNS or PNS lesion site, Applicants submit that the rejection is rendered moot.

In view of the above considerations, Applicants request that the rejections under 35 U.S.C. §102(b) be withdrawn.

CONCLUSION

In summary, for the reasons set forth above, Applicants maintain that the pending claims patentably define the invention. Applicants request that the Examiner reconsider the rejections as set forth in the Office Action and permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' undersigned representative can be reached at the telephone number listed below.

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Filed herewith is a Petition for Automatic Extension with the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12/1/00



Stuart Macphail, Ph.D.
Reg. No. 44,217

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, NY 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291